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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,474

12/28/2004

Mami Nonomura

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2696

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7590

12/22/2008

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ALEXANDRIA, VA 22314

EXAMINER

WHITE, EVERETT NMN

ART UNIT

PAPER NUMBER

1623

NOTIFICATION DATE

DELIVERY MODE

12/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/519,474	<b>Applicant(s)</b> NONOMURA ET AL.	
	<b>Examiner</b> EVERETT WHITE	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 22, 2008 has been entered.

2. The amendment filed September 22, 2008 has been received, entered and carefully considered. The amendment affects the instant application accordingly:

- (A) Claims 10 and 11 were previously canceled;
- (B) Claims 7, 8, 16 and 17 have been amended;
- (C) Comments regarding Office Action have been provided drawn to:
  - (I) 102(b) rejection, which has been maintained for the reasons of record;
  - (II) 103(a) rejections, which have been maintained for the reasons of record.

3. Claims 1-9 and 12-21 are pending in the case.

4. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

#### ***New Ground of Rejection***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7, 8, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to amended claims herein has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for "a face mask" since the specification as originally filed does not describe the mask thereof as a face mask.

7. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive. Applicants point to page 14, second paragraph, for support of phrase "face mask", wherein Applicants cites the text "a mask can be fabricated by attaching ear hangers to the sheets, by forming ear hanger holes in the sheet material, or inserting the sheet between the mask and the mouth." However, the cited text does not mention "a face mask".

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6, 9, 12-14 and 18-21 stand rejected under 35 U.S.C. 102(b) as being anticipated by Nagasawa et al (WO 00/73351 A1) for the reasons disclosed in the Office actions filed August 16, 2007 and reasons argued in the Office Action filed April 21, 2008.

10. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the Nagasawa et al reference does not describe selecting a cellulose ether as a backbone for polysaccharide derivatives, wherein the cellulose ether has an average molecular weight of 100,000 to 600,000 or 100,000 to 200,000. The argument is not persuasive since the Nagasawa et al references clearly establish that the polysaccharide thereof may be selected as cellulose ether which has an average molecular weight within the

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instantly claimed range. For example, see the English Language equivalent, US Pat. 6,541,614, in column 5, line 13, which discloses hydroxyethylcellulose as being particularly preferred. Also, see column 5, lines 22-25 of US Pat. 6,541,614, wherein weight average molecular weight of the polysaccharide or its derivatives is more preferably from 100,000 to 5,000,000, which clearly cover the average molecular weight range recited in the instant claims.

Applicant argue that Nagasawa et al do not make the claimed agent obvious because the allergen inactivating effect of the Nagasawa polysaccharides would not have been expected. This argument is also not persuasive since the polysaccharide derivatives specified in the instant claims are identical to the polysaccharide derivatives disclosed in the Nagasawa et al references when the polysaccharide is selected as cellulose. Applicants are reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01

Accordingly, the rejection of Claims 1-6, 9, 12-14 and 18-21 under 35 U.S.C. 102(b) as being anticipated by the Nagasawa et al reference is maintained for the reasons of record.

### ***Claim Rejections - 35 USC § 103***

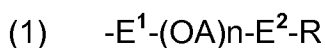
11. Claims 1- 5, 8, 9, 12-14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa et al (WO 00/73351 A1) in view of Golz-Berner et al (US Patent No. 6,245,342).

Applicants claim an allergen inactivating agent comprising a polysaccharide derivative as its effective component, wherein said polysaccharide derivative has a cellulose ether as its backbone, and some or all of hydrogen atoms in the hydroxy group of the polysaccharide derivative are substituted by a group represented by the following general formula (I):



wherein  $E^1$  represents an alkylene containing 1 to 6 carbon atoms optionally substituted with hydroxy group or oxo group;  $n$  represents a number of 0 to 50;  $A$  independently represents an alkylene containing 1 to 6 carbon atoms, the number of  $A$  being  $n$ ;  $E^2$  represents ether bond or oxycarbonyl group;  $R$  represents an alkyl group containing 4 to 30 carbon atoms optionally substituted with hydroxy group, a sulfoalkyl group containing 1 to 5 carbon atoms optionally substituted with hydroxy group, or a salt thereof, wherein the cellulose ether has an average molecular weight of 100,000 to 600,000. Applicants further claim a face mask comprising the allergen inactivating agent.

The Nagasawa et al WO publication discloses a polysaccharide derivative having a structure formed by replacing part or all of the hydrogen atoms of the hydroxyl groups in a polysaccharide or a derivative thereof with a group represented by the formula



wherein  $E^1$  represents  $C_{1-6}$  divalent saturated hydrocarbon group optionally substituted by hydroxy or oxo;  $n$  is a number of 8 to 300;  $nA$ 's are the same or different and each represents a  $C_{1-6}$  divalent saturated hydrocarbon group;  $E^2$  represents an ether bond or oxycarbonyl; and  $R$  represents  $C_{4-30}$  alkyl optionally substituted by hydroxyl (see Abstract). The specification of the Nagasawa et al publication discloses hydroxyethyl cellulose as an example of the polysaccharide derivative (see page 5 of the machine translated document), which embraces instant Claim 3. The different sources of the allergen as recited in instant Claim 2 are noted, but have not been given patentable weight since the allergen inactivating agent, per se, recited therein does not change. The presence of the polysaccharide derivative inherently treats allergen in the various toiletry cited in the Nagasawa et al publication since products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ 2d 1655, 1658 (Fed. Cir.1990). See MPEP 2112.01. See page 6, 2<sup>nd</sup> paragraph of the machine translated document of the Nagasawa et al publication wherein weight average molecular weight of the polysaccharides thereof ranges from

10,000 to 5 million, which covers the molecular weight range recited in instant Claims 1 and 13.

The instantly claimed allergen inactivating agent comprising a polysaccharide derivative selected as cellulose ether as its effective component of the instant claims differs from the polysaccharide derivative of the Nagasawa et al publication by claiming a cosmetic product comprising an allergen inactivating agent.

The Golz-Berner et al patent shows that the present of hydroxyethylcellulose, a cellulose ether, in a cosmetic product is known in the art. See column 3, lines 13-15 of the Golz-Berner et al patent wherein hydroxyethylcellulose is disclose as a convention additive or vehicle for use in substances such as cosmetics.

One of ordinary skill in this art would be motivated to combine the teaching of the Nagasawa et al publication with the teaching of the Golz-Berner et al patent since both references disclose hydroxyethyl cellulose as a component of cosmetic products. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the hydroxyethylcellulose of the Nagasawa et al publication with another hydroxyethyl cellulose in view of the recognition in the art, as evidenced by the Golz-Berner et al patent, that the hydroxyethylcellulose is a conventional additive or vehicle for use with cosmetic.

12. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the prior art used in the rejection do not recite a face mask. The current rejection of the claims is not base on the face mask.

13. Claims 1-6, 9, 12-15 and 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasawa et al (WO 00/73351 A1) in view of Palinczar (US Patent No. 4,671,955) for the reasons disclosed on pages 6-8 of the Office Action filed April 21, 2008.

14. Applicant's arguments filed September 22, 2008 have been fully considered but they are not persuasive. Applicants argue against rejection on the ground that Nagasawa et al and Palinczar do not make the claimed agent obvious because the

allergen inactivating effect of the Nagasawa polysaccharides would not have been expected. Applicants argue that the polysaccharides having the claimed ranges of molecular weight advantageously provide the allergen inactivating effect that is quite different from the thickening effect of Nagasawa. This argument is not persuasive because one would be motivated to combine the teaching of the Nagasawa et al publication with the teaching of the Palinczar patent since both references disclose hydroxyethyl cellulose as a component of cosmetic products. The Nagasawa et al publication discloses an average molecular weight range that covers the average molecular weight range recited in the instant claims. Accordingly, the rejection of Claims 1-6, 9, 12-15 and 18-21 under 35 U.S.C. 103(a) as being unpatentable over Nagasawa et al publication in view of Palinczar patent is maintained for the reasons of record.

### ***Summary***

15. All the pending claims (Claims 1-9 and 12-21) are rejected.

### ***Examiner's Telephone Number, Fax Number, and Other Information***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVERETT WHITE whose telephone number is (571)272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-066127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic



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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/

Examiner, Art Unit 1623

/Shaojia Anna Jiang/

Supervisory Patent Examiner, Art Unit 1623